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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/727,290

12/03/2003

Peter M. Bonutti

780-A03-012D

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03/06/2008

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EXAMINER

PHILOGENE, PEDRO

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

03/06/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/727,290	<b>Applicant(s)</b> BONUTTI, PETER M.	
	<b>Examiner</b> Pedro Philogene	<b>Art Unit</b> 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8,9,10,14,29 is/are allowed.
- 6) ☒ Claim(s) 1-7,11-13,15-28 and 30-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

***Priority***

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. The examiner agrees with applicant, for purpose of examination, the application is entitled to a priority date of the file date of application No. 09/941,185, or August 28, 2001.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 11-13,15-28,30-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacArthur. (6,342,075) in view of Engh et al. (6,482,209).

MAcArthur discloses a prosthetic implant system for repairing a knee joint in a body of a patient, comprising a first member (90) including a first articulating member, the first member affixable to only one of a medial and lateral condyle of a femur portion

of the knee joint; as best seen in FIG.8, a second member (90) including an articulating surface, the second member affixable to a trochlear section of the femur portion; as best seen in FIG.9 (at the intercondylar notch or trochlear section (28)); a third member (100) including a third articulating surface, the third member affixable to an end portion of a tibia portion of the knee joint opposite the first member; as best seen in FIG.2.

With respect to claims 2,6-11, MacArthur discloses all the limitations; as set forth in column 8, lines 15-67, column 13, lines 1-67, column 14, lines 1-67, column 15, lines 1-67, column 14, lines 1-30.

With respect to the method claims, the method steps, as set forth, would have been inherently carried out in the operation of the device, as set forth above.

It is noted that McArthur did not teach that first and the second are connected; as claimed by applicant. However, McArthur teaches that the first and second members are separable. Since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art; or, forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. See *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893); *Nerwin v. Erlichman*, 168 USPQ 177, 179; it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the first and second members of McArthur et al by connecting them to facilitate proper alignment and orientation of the joint to restore kinematics.

It is noted that MacArthur did not teach of a first articulating surface operative as a weight bearing surface throughout the normal range of motion of the joint for the only

one condyle and wherein the first and second implants are implanted without a requirement for severing either cruciate ligament; as claimed by applicant. However, in similar art, Engh et al (FIGS.37-42) evidence the use of a prosthetic implant wherein the first articulating surface operative as a weight bearing surface throughout the normal range of motion of the joint for the only one condyle and wherein the first and second implants are implanted without a requirement for severing either cruciate ligament to provide an implant system that restores individual patient joint kinematics and involves minimally invasive surgical procedures.

Therefore, given the teaching of Engh et al, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of MacArthur, as taught by Engh et al to provide an implant system that restores individual patient joint kinematics and involves minimally invasive surgical procedures.

***Allowable Subject Matter***

Claims 8, 9, 10, 14, 29 are allowed.

***Response to Amendment***

Applicant's arguments, see Remarks, filed 10/10/07, with respect to the rejection(s) of claim(s) 1-41 under 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Engh et al. Engh et al discloses a an implant having a first member including a first elongate articulating surface, the first articulating surface operative as a weight bearing surface throughout the normal Range of motion of the joint for the only one condyle; as best seen in FIGS.37-43; wherein the

Art Unit: 3733

first and second implants are implanted without requirement for severing either cruciate ligament; as best in FIGS .1-4 Wherein the any of the first, second, and third members may be implanted irrespective of the implantation of any other of the first, second, and third members; and wherein the first, second, and third members are implantable without a requirement for severing either cruciate ligament; as set forth in column 13, lines 44-67, column 14, lines 1-67, column 15, lines 1-50.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-

Art Unit: 3733

4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pedro Philogene/  
Primary Examiner, Art Unit 3733  
February 27, 2008